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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,625	03/31/2004	Kaori Saito	50024-034	3850

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MCDERMOTT, WILL & EMERY
600 13th Street, N.W.
Washington, DC 20005-3096

EXAMINER

YAMNITZKY, MARIE ROSE

ART UNIT	PAPER NUMBER
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1774

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/813,625

Applicant(s)

SAITO, KAORI

Examiner

Marie R. Yamnitzky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-8 and 11 is/are rejected.
- 7) ☒ Claim(s) 2,3,9 and 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>27 Oct 2006</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. This Office action is in response to applicant's amendment filed October 27, 2006, which amends claims 1, 2 and 8-11.

Claims 1-11 are pending.

2. The examiner acknowledges receipt of certified copies of JP 2003-097303 and JP 2004-088149, and certified translations thereof. The certified copies and translations were received October 27, 2006.

3. The references cited on the Information Disclosure Statement filed October 27, 2006 have been considered by the examiner and are made of record.

4. The rejections based on WO 2004/003053 A1 and WO 03/084973 A1 are withdrawn in consideration of the certified translation of JP 2003-097303. JP 2003-097303 supports the present claims and was filed prior to the publication dates of the two WO documents. (For the record, the rejection based on WO '053 was intended to be a rejection under 35 U.S.C. 103(a) rather than 102(a) as erroneously indicated in the first line of the rejection.)

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 4-8 and 11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ikehira et al. (US 2002/0193532 A1) for reasons of record in the Office action mailed July 27, 2006.

7. Applicant's arguments filed October 27, 2006 have been fully considered but they are not persuasive with respect to the rejection based on Ikehira et al.

Applicant argues that Ikehira discloses a polymeric light emitting substance whereas the present invention does not teach a polymeric structure. Applicant argues that the structures listed in paragraph [0078] of Ikehira are linking agents to form a polymeric structure rather than substituents. Applicant argues that the boron containing compound disclosed by Ikehira would not be considered a "substituent" by one skilled in the art.

These arguments are not persuasive. While pages 20-22 disclose various substituents, the "substituent" of the claims is not limited to the disclosed possibilities. The examiner reads no limitations into the term "substituent" other than that a substituent must apparently be an atom or group other than a hydrogen atom since "substituent" is set forth in the claims as an alternative to a hydrogen atom.

Applicant also refers to effects discussed in the specification with respect to compounds that contain boron according to the present invention, and argues that Ikehira is silent with respect to these effects. This argument is not persuasive because the only objective data set forth in the specification with respect to the argued effects pertain to compounds according to claim 3.

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There are numerous compounds within the scope of formula (1) as defined in the independent claims that are not compounds according to claim 3.

8. Miscellaneous:

Formula (1) as shown in present independent claims 1, 8 and 11 is incomplete as it does not show a dotted line extending from the nitrogen in the pyridine ring to M. (Compare to formula (1) as shown in the original claims.)

In claim 10, the period should be moved from the end of line 3 to the end of the claim (i.e. after the formula).

Appropriate correction is required.

9. Claims 2, 3, 9 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, with correction of the informalities noted above with respect to formula (1) and claim 10.

The prior art does not disclose or suggest a compound of formula (1) wherein at least one of R1 to R8 is a substituent expressed by formula (2) as required by present claims 2 and 3.

The prior art does not disclose or suggest an organic light emitting device having a light emitting layer between a pair of electrodes wherein the light emitting layer comprises a host material and a compound of formula (1) wherein the content of the compound of formula (1) is in the range of 0.1-30% by weight of the host material as required by present claims 9 and 10.

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10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

11. Any inquiry concerning this communication should be directed to Marie R. Yamnitzky at telephone number (571) 272-1531. The examiner works a flexible schedule but can generally be reached at this number from 7:00 a.m. to 3:30 p.m. Monday-Friday.

The current fax number for all official faxes is (571) 273-8300. (Unofficial faxes to be sent directly to examiner Yamnitzky can be sent to (571) 273-1531.)

MRY
January 08, 2007



MARIE YAMNITZKY
PRIMARY EXAMINER

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